

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/960,396 Confirmation No. : 5628
First Named Inventor : Stephen MCCANN
Filed : September 24, 2001
TC/A.U. : 2137
Examiner : J. L. Williams

Docket No. : 038819.50289
Customer No. : 23911

Title : Access Authentication System

Petition Under 37 C.F.R. § 1.144

Mail Stop Petition

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition for reconsideration and withdrawal of the Restriction Requirement issued on May 2, 2007.

The present application is pending with current claims 1-9 and 11-22. The claims were subject to a Restriction Requirement, mailed May 2, 2007. Applicants' arguments traversing the Restriction Requirement were filed May 18, 2007. This Restriction Requirement was made final in the Office Action mailed August 10, 2007.

Applicants respectfully submit that the Restriction Requirement is improper because there is no serious burden on the Examiner to continue to search and examine claims 1-9 and 21 along with claims 11-15. Furthermore, the

Examiner's own actions demonstrate that the classification of the claim groups is arbitrary and not based on an actual search classification.

It is well established that a restriction requirement is proper only when "there would be a serious burden on the examiner if restriction is not required."¹

There cannot possibly be a *serious burden* to search and examine 1-9 and 21 along with claims 11-15 because these claims have already been searched and examined together. Specifically, these claims were searched, examined and rejected on the same grounds of rejection in the Office Action issued on October 3, 2006. Accordingly, at that time the Examiner clearly did not find a serious burden to search, examine and reject these claims together. The Office Action has not, however, provided any evidence demonstrating a change in circumstance that would now result in a burden.

The Office Action mailed August 10, 2007, concludes that Applicants' amendments in the response filed on February 1, 2007, required a reclassification of the claims from the previous restriction requirement issued on October 3, 2006, and also resulted in different search areas being required to search and examine these claims.

¹ M.P.E.P. § 808.02.

The Office Action mailed on October 3, 2006, required a restriction with the following claim groupings:

- Group I. claims 1-15 and 21 identified as being classified in class 713, subclass 150; and
- Group II. claims 16-20 classified in class 726, subclass 17 and class 705, subclass 30.

The Restriction Requirement issued on May 2, 2007, required restriction with the following claim groupings:

- Group I. claims 1-9 and 21 identified as being classified in class 380, subclass 28 and class 726, subclass 9; and
- Group II. claims 11-15 identified as being classified in class 726, subclass 17 and class 705, subclass 30.

In Applicants response filed subsequent to the Restriction Requirement issued on May 2, 2007, claim 1 was amended to recite "a valid cellular mobile account for the mobile telephone." Clearly, this minor amendment could not have resulted in a complete reclassification of claims 1-9 and 21 from the classification provided in the Restriction Requirement issued on October 3, 2006. Furthermore, claims 11-15 were not amended, and accordingly there are no amendments to these claims that could have resulted in a completely new search classification of these claims from the classification provided in the Restriction Requirement issued on October 3, 2006.

The Examiner's own search results also demonstrate that there is no serious burden to examine the claims of Group 1 with the claims of Group 2. Specifically, the Examiner has rejected the claims of Group 1 in a number of Office Actions. Accordingly, there could be no burden to continue to search and examine these claims as the claims have already been searched and examined. Regarding the claims of Group 2, these are identified as being classified in class 726, subclass 17 and class 705, subclass 30. As demonstrated by the Examiner's search notes, class 705, subclass 30 has already been searched in connection with the examination of the claims of Group 1 in the Office Action issued on August 10, 2007.

Furthermore, the Examiner's own search results demonstrate that the classification of the claims for the purposes of the Restriction Requirement were completely arbitrary, and not based upon the actual search areas required for examination. The Examiner has searched, examined and rejected claims 1-9 and 21 in a number of different Office Actions. However, the Examiner's search results indicate that *class 380, subclass 28 and class 726, subclass 9 have never been searched*. Clearly if claims 1-9 and 21 are properly classified in class 380, subclass 28 and class 726, subclass 9, a search would have to have been conducted in these search areas. *The Examiner's failure to search these art areas clearly demonstrates that there is no basis for the classification of the claims of Group 1.* Thus, the Examiner's own actions have demonstrated that the classification of the claims of Groups 1 and 2 is arbitrary and the Examiner has failed to provide any

evidence to support the assertion that there would have been a burden to search and examine the claims of Group 1 and 2 together.

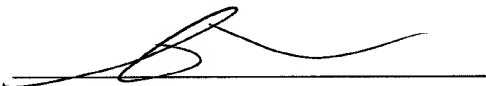
Because the Examiner has not provided evidence that there would be a serious burden to search and examine the claims of Groups 1 and 2 together, and the only evidence provided to support such a burden is an arbitrary classification of the claims that is not even supported by the Examiner's own search and examination, the Restriction Requirement issued on May 2, 2007, is improper and should be withdrawn.

If there are any questions regarding this application, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #033819.50289US).

Respectfully submitted,

October 30, 2007


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